



## UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Atty Dkt. 912-27

C# M#

LEE et al

Group Art Unit: 1637

Serial No. 10/058,422

Examiner: Tung, Joyce

Filed: January 30, 2002

Date: May 23, 2003

Title: A METHOD FOR IDENTIFYING MYCOBACTERIUM TUBERCULOSIS AND MYCOBACTERIA OTHER THAN TUBERCULOSIS, TOGETHER WITH DETECTING RESISTANCE TO AN ANTITUBERCULOSIS DRUG OF MYCOBACTERIA OBTAINED BY MUTATION OF RPOB GENE

RECEIVED

MAY 28 2003

TECH CENTER 1600/2900

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☒ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment	0	minus highest number		
previously paid for	20	(at least 20) =	0 x \$ 18.00	\$ 0.00
Independent claims after amendment	0	minus highest number		
previously paid for	3	(at least 3) =	0 x \$ 84.00	\$ 0.00
If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper)				\$ 0.00
Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$410.00/2 months; \$930.00/3 months)				\$ 110.00
Terminal disclaimer enclosed, add \$ 110.00				\$ 0.00
<input type="checkbox"/> First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$750.00)				\$ 0.00
<input type="checkbox"/> Please enter the previously unentered, filed				
<input type="checkbox"/> Submission attached				
			<b>Subtotal</b>	<b>\$ 0.00</b>
If "small entity," then enter half (1/2) of subtotal and subtract				-\$ 0.00
<input type="checkbox"/> Applicant claims "small entity" status. <input type="checkbox"/> Statement filed herewith				
Rule 56 Information Disclosure Statement Filing Fee (\$180.00)				\$ 0.00
Assignment Recording Fee (\$40.00)				\$ 0.00
Other:				<b>0.00</b>
			<b>TOTAL FEE ENCLOSED</b>	<b>\$ 110.00</b>

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.  
By Atty: Gary R. Tanigawa, Reg. No. 43,180

Signature: 

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

LEE et al.

Appln. No. 10/058,422

Filed: January 30, 2002

FOR: A METHOD FOR IDENTIFYING MYCOBACTERIUM TUBERCULOSIS AND  
MYCOBACTERIA OTHER THAN....MUTATION OF rpoB GENE

Atty. Ref.: 912-27

Group Art Unit: 1637

Examiner: J. Tung

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RESPONSE TO RESTRICTION REQUIREMENT

May 23, 2003

Hon. Commissioner for Patents  
Arlington, VA 22202

Sir:

In response to the pending Office Action (Paper No. 7) mailed March 25, 2003, entry and consideration of the following remarks are respectfully requested.

Claims 1-14 are pending. Applicants elect Group II (claims 8-14) with traverse for examination on the merits. With regard to the requirement for an election of species, SEQ ID NO:1 is elected. Applicants reserve the right to prosecute nonelected subject matter in a further patent application.

Reconsideration of the restriction requirement is requested.

The different nucleic acids are patentably distinct, but it would not constitute an undue burden for more than one nucleotide sequence to be examined in this application because, in particular, the M.P.E.P. § 803.4 refers to the sua sponte waiver of 37 CFR 1.141 et seq. and states that "up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction" (emphasis added). In accordance with this direction, Applicants make the further election of species: two primers of SEQ ID NOS:1 and 2 and seven probes of SEQ ID NOS: 3, 5, 6, 9, 10, 13 and 14.

Such nucleic acids can be incorporated into a kit to identify *Mycobacterium tuberculosis* and non-tuberculosis *Mycobacterium* (see claim 13) and to determine susceptibility of *M. tuberculosis* to the antituberculosis drugs obtained by the mutation of the rpoB gene (see claim 14) as can be seen in Figs. 5-7.

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Although the inventions identified by the Examiner are separately patentable, it would not constitute an undue burden to search and examine the claims of both Groups I and II in the same application. Both the need for compact prosecution and the public interest would be served by examination of all claims in a single application.

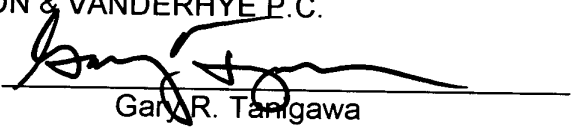
Furthermore, under the Commissioner's Notice of March 26, 1996 (1184 OG 86) implementing the Federal Circuit's decisions of *In re Ochiai*, 37 USPQ2d 1127 (1995) and *In re Brouwer*, 37 USPQ2d 1663 (1996), rejoinder of process claims is requested upon an indication that a product claim is allowable.

Applicants earnestly solicit an early and favorable examination on the merits. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:

  
Gary R. Tangawa  
Reg. No. 43,180

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